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Interference No. 101,096
Fiers
v.
Revel et al.
v.
Sugano et al.

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Receipt is acknowledged of the following papers:

1. Revel et al. motions to dissolve:

- I. With respect to Sugano et al. for lack of support, and;
- II. With respect to Fiers for unpatentability; filed on July 20, 1984 (Paper No. 24).

2. Conditional motion by Revel et al. to amend the issue by substituting Count 2 and adding Counts 3-6, filed on July 20, 1984 (Paper No. 25).

3. Revel et al. motion to declare additional interferences, filed on July 20, 1984 (Paper No. 26).

4. Revel et al. motion for benefit under 37 CFR 1.231(a)(4), filed on July 20, 1984 (Paper No. 27).

5. Sugano et al. motion under 37 CFR 1.231 for benefit, filed on July 23, 1984 (Paper No. 29, C of Mail 7/20/84).

6. Memo in support of item 5, filed therewith (Paper No. 30).

7. Fiers motion for benefit and to shift the burden of proof, filed on July 23, 1984 (Paper No. 31, C of Mail 7/20/84).

8. Fiers motion to amend by substitution or addition of Count 2 and addition of Counts 3-9 and for benefit, filed on July 23, 1984 (Paper No. 32, C of Mail 7/20/84).

9. Fiers motion to dissolve and deny benefit with respect to Revel et al., filed on July 23, 1984 (C of Mail 7/20/84, Paper No. 33).

10. Fiers motion to dissolve because Count 1 is not patentable to Sugano et al., filed on July 23, 1984 (C of Mail 7/20/84, Paper No. 34).

11. Revel et al. conditional motion to amend, filed on November 5, 1984 (Paper No. 59).

Various oppositions and replies have been filed with respect to these motions.

Initially it is noted that the party Fiers filed bound motions, i.e., the left edge of all motions had been bound like a textbook. Since a patent interference file contains a fastener at the top of the file so that each page can be fastened into the file at the top, the bound motions are extremely inconvenient to work with. They have to be removed physically from the file to be read. Because of this, the bound edge, including the binding has been removed. The party Fiers is hereby requested not to file any further motions in this interference proceeding which are bound. The amount of time needed to remove the binding is non-productive concerning resolution of the issues in deciding what motions to transmit to the Primary Examiner for decision, and detracts from expeditious prosecution of this proceeding. Should this interference reach final hearing, the parties may bind their briefs, preferably with a spiral binding, to lie flat, in accordance with 37 CFR 1.254. Briefs at final hearing are not placed into the interference file jacket and therefore may be considered without the necessity to remove the bindings.

The Revel et al. conditional motion to amend, item 2, will be transmitted conditioned (as moved) on the denial of

the Revel et al. motion to dissolve with respect to Fiers because of alleged unpatentability. The conditional nature of the motion, coupled with a "de minimis" patentability demonstration based on the primary examiner's determination that the subject matter in issue is patentable to all parties, plus the explicit detailed reasoning presented in the motion showing why the patentability of the existing count applies to the proposed count, satisfies the requirements of 37 CFR 1.231(a)(2) regarding demonstration of patentability of the proposed counts to all parties, and the incorporated requirement of 37 CFR 1.231(b), first sentence.

The Revel et al. motion for benefit, including the declarations and material attached thereto, will be transmitted to the primary examiner for decision. The declarations and attached material are considered in the nature of a 37 CFR 1.132 showing on the issue of inherency. Since a primary examiner could consider this material in ex parte prosecution, In re Maqerlein, 346 F.2d 609, 145 USPQ 683 (CCPA 1965); Ex parte Marsili et al., 214 USPQ 904 (PTO Bd. App. 1979), and since declarations or affidavits of this nature (37 CFR 1.132) are proper to be considered by a primary examiner in reaching a decision on motions, Roller v. Goodwin, 1921 C.D. 11 (Comm'r. 1929), transmission of the entire motion, including the declarations and attached material is proper.

The Fiers motion for benefit and to shift the burden of proof is dismissed to the extent that it seeks to shift the burden of proof. The burden of proof as to each count is set by 37 CFR 1.257(a). The question of which party will be designated the senior party will be determined as a matter of course after the 37 CFR 1.231 motions have been decided. See M.P.E.P. §1105.04, last paragraph.

The Fiers motion to amend by substitution or addition of proposed Count 2 and by the addition of proposed Counts 3-9 is dismissed. The motion is not conditional on the denial of the Fiers motions to dissolve and does not contain an adequate, in the sense of 37 CFR 1.231(b), first sentence, demonstration of patentability of the proposed counts to the other parties, as required by 37 CFR 1.231(a)(2) and 37 CFR 1.231(b), first sentence. It merely concludes that the proposed counts are patentable to the other two parties as is the existing count. It fails to contain the grounds for such a conclusion and the reasoning in support thereof.

The Revel et al. conditional motion to amend is dismissed for being belatedly filed with insufficient cause presented to excuse the belatedness. The parties were given ample time in which to determine, prepare and file appropriate motions under 37 CFR 1.231, including motions to amend, two of the parties filed timely motions to amend. This motion was not filed until three and one half months after the time to file motions under 37 CFR 1.231 expired and over a month after the time to file motions to amend under 37 CFR 1.231(b). The fact that this motion admittedly did not occur to the party Sugano et al. until long after the time to file motions to amend under 37 CFR 1.231(b) indicates that it is not properly brought as a 37 CFR 1.231(b) motion. Accepting a belated motion under the circumstances present in this instance is not proper. It is better to insist on a reasonable and just compliance with the rules of practice, although it may work a hardship in a particular case, than to adopt a policy of accepting quite belated papers in every case which would lead to an abrogation of the rules of practice, Felbel v. Fox, 1907 CD 312 (Comm'r. 1907).

Moreover, this motion is an example of piecemeal prosecution, Richards v. Kletzer, 1902 CD 62 (Comm'r. 1902), which is to be avoided in patent interference practice.

In the Fiers motion to amend and reply in support thereof, Fiers requests that Revel et al. be required to demonstrate the patentability of proposed Counts 3-9 to themselves as well as support for the proposed counts in their U.S. applications, or otherwise be estopped from asserting a right to the subject matter of those counts in subsequent ex parte or interference proceedings. The request is moot until subsequent ex parte or interference proceedings occur. Accordingly, it is dismissed as moot.

In summary, the Revel et al. motions to dissolve; the Revel et al. conditional motion to amend, the Revel et al. motion to declare an additional interference; the Revel et al. motion for benefit; the Sugano et al. motion for benefit; the Fiers motion for benefit (but not the portion which seeks to shift the burden of proof); and the Fiers motions to dissolve and to deny benefit will be transmitted to the Primary Examiner in due course for decision on their merits.

Ronald H. Smith
Ronald H. Smith
Examiner of Interferences
(703) 557-4016

RHS/lal